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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/940,174	08/27/2001	Lane W. Lee	M-12038 US	5308

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EXAMINER

HEWITT II, CALVIN L

ART UNIT PAPER NUMBER

3621

DATE MAILED: 01/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/940,174

Applicant(s)

LEE ET AL.

Examiner

Calvin L Hewitt II

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 October 2004.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,6,11-15,17,18 and 22 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-3,6,11-15,17,18 and 22 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Status of Claims

1. Claims 1-3, 6, 9, 11-15, 17, 18, 21 and 22 have been examined.

Response to Arguments/Amendments

2. Applicant's arguments with respect to claims 1-3, 6, 9, 11-15, 17, 18, 21 and 22 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-3, 6, 9, 11-15, 17, 18, 21 and 22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 15 and 22 recite detecting an unauthorized action "... if the identifier identifies itself as a pre-recorded identifier and is located in the second portion of the media disk...". However, the Applicant's method is silent regarding

how the method is to perform if the identifier is *not* a pre-recorded identifier or it is *not* located in the second portion. Hence, one of ordinary skill is hindered from determining how to practice Applicant's claimed method, apparatus and system and the scope of said claims.

Claims 2, 3, 6, 9, 11-14, 17, 18 and 21 are also rejected as they depend from claims 1, or 15.

Claim 11 recites the limitation "the validation function" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-3, 6, 11-15, 17, 18, and 22 rejected under 35 U.S.C. 102(e) as being clearly anticipated by Harada et al., U.S. Patent 6,581,160.

As per claims 1-3, 6, 11-15, 17, 18, and 22, Harada et al. teach an apparatus for detecting unauthorized actions comprising:

- reading (e.g. media disk access operation, record, play, get play key copy, open, close or create) an identifier on the media disk (media disk, CD, DVD, or other storage medium) wherein the identifier is located in one of: prerecorded content (first location) (column 7, lines 12-26 and 47-60; column 9, lines 3-44), written content (second location) (column 13, lines 31-48) or prerecorded and written content (column/line 13/48-14/16) (abstract; and 47-60;
- detecting an unauthorized action if the identifier is prerecorded and written content (column/line 13/31-14/16)
- revoking media access upon detecting an unauthorized action (i.e. providing a failure indication) (column/line 13/31-14/16)
- detecting unauthorized actions when a media disk is accessed by an engine under DRM control (abstract)
- an identifier that is located on a media disk that is coupleable to one of a(n): engine, device that embeds an engine, third party DRM protocol, an application running in an open computing environment and a clearinghouse server (figures 1 and 2)
- an identifier that is one of a plurality of identifier on the media disk, associated with one or more files on a media disk, each identifier being written content or prerecorded content (figure 3; column/line 8/27-9/42; 13/31-14/16)

- wherein one of the plurality of identifiers is unique to the media disk
(column 8, lines 27-60)

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 9 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harada et al., U.S. Patent No. 6,581,160.

As per claims 9 and 21, Harada et al. teach reading an identifier on a media disk (abstract). Claims 9 and 21 are dedicated to a description of the identifier. However, this is non-functional data as the method and apparatus do not perform key generation and using a generated key to decrypt files. Recall claims 1 and 15, from which claims 9 and 21 depend, respectively, are dedicated to detecting unauthorized actions. The MPEP defines non-functional descriptive material as data that does not alter the performance of a process or computer (2106 section V, B, 2). Therefore, to one of ordinary skill once said unauthorized action is identified no further processing or access is permitted (for example see claim 3) (descriptive material cannot render nonobvious an invention that would

have otherwise been obvious (*In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) (when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability)).

Conclusion

9. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Calvin Loyd Hewitt II whose telephone number is (703) 308-8057. The Examiner can normally be reached on Monday-Friday from 8:30 AM-5:00 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, James P. Trammell, can be reached at (703) 305-9768.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
c/o Technology Center 2100
Washington, D.C. 20231

or faxed to:

(703) 305-7687 (for formal communications intended for entry and after-final communications),

or:

(703) 746-5532 (for informal or draft communications, please label
"PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park 5,
2451 Crystal Drive, 7th Floor Receptionist.

Any inquiry of a general nature or relating to the status of this application
should be directed to the Group receptionist whose telephone number is (703)
308-1113.

Calvin Loyd Hewitt II
January 9, 2005



JAMES P. TRAMMELL
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600